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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,659	01/22/2004	Paul B. Moody	260-009 LOT9-2003-0110US1	5149
44185 7590 07/16/2007 LOTUS AND RATIONAL SOFTWARE McGuinness & Manaras LLP 125 NAGOG PARK ACTON, MA 01720			EXAMINER ABDUL-ALI, OMAR R	
			ART UNIT 2178	PAPER NUMBER
			MAIL DATE 07/16/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/762,659

Applicant(s)

MOODY ET AL.

Examiner

Omar Abdul-Ali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04/23/2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The following action is in response to the response filed April 23, 2007. Amended Claims 1-32 are pending and have been considered below.

#### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 32 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A carrier wave is a form of energy, and does not fall within one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (process, machine, manufacture, or composition of matter).

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 11, 21, 31 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Curbow et al. (US 7,076,043).

Claims 1, 11, 21, 31, and 32: Curbow discloses a system and method of using presence information to delay dialing phone calls initiated by a caller to a callee comprising:

- a. obtaining an online status of a remote computer system user (page 4, paragraph 48);
- b. presenting an indication of said online status of said remote computer system user (page 4, paragraph 48);
- c. obtaining communication mode activity that includes the identity of at least one asynchronous communication application (instant messaging service/buddy list) used by said remote computer system user (page 4, paragraph 55);
- d. presenting communication mode activity information in a display for said local computer system (page 4, paragraph 55).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-7, 12-17, 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curbow et al. (7,076,043).

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Claims 2, 12, and 22: Curbow discloses a system and method of using presence information to delay dialing phone calls initiated by a caller to a callee as in Claims 1, 11, and 21 above, but does not explicitly disclose the time at which at least one asynchronous communication application was used by said remote user. However, Official Notice is taken that it is old and well known in the art that a time stamp can be applied whenever a communication application is used. Such time stamps are routinely used in the computer arts to generate usage logs. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply a time stamp to the communication application being used. One would have been motivated to apply a time stamp to the communication application to determine when the most recent usage of the communication application occurred.

Claims 3, 13, and 23: Curbow discloses a system and method of using presence information to delay dialing phone calls initiated by a caller to a callee as in Claims 2, 12, and 22 above, further comprising:

- a. said communication mode activity information further comprises at least one resource (device) used when said at least one asynchronous communication application was used by remote user (page 4, paragraph 55).

Claims 4, 14, and 24: Curbow discloses a system and method of using presence information to delay dialing phone calls initiated by a caller to a callee as in Claims 3, 13, and 23 above, but does not explicitly disclose that the resource comprises a file

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used by said at least one asynchronous communication application. However, Official Notice is taken that it is old and well known in the art to monitor the files accessed by a remote user while using a communication application. Such monitoring is used in the computer arts to determine access fees to be charged to the user. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to track the file used by said communication application. One would have been motivated to monitor the files accessed by the user in order to keep track of a user's activity.

Claims 5, 15, and 25: Curbow discloses a system and method of using presence information to delay dialing phone calls initiated by a caller to a callee as in Claims 3, 13, and 23 above, further comprising indicating to remote users that two users are currently engaged in conversation (page 4, paragraph 51). This system does not explicitly disclose that the communication mode activity information further comprises a time duration for which said at least one asynchronous communication application was used by said remote computer system user, however Official Notice is taken that it is old and well known in the art to display the time duration of conversations in real time. Time duration displays are used by the computer arts to inform the user of the remaining time when accessing a pre-paid resource. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to disclose the time duration of a conversation between two parties to a remote user. One

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would have been motivated to display the time duration of the call to allow a local user to estimate how long the remote user will be busy.

Claims 6, 16, and 26: Curbow discloses a system and method of using presence information to delay dialing phone calls initiated by a caller to a callee as in Claims 5, 15, and 25 above, further comprising:

- a. said communication mode activity information further comprises identity of another user with whom said remote computer system user is communicating (page 4, paragraph 51).

Claims 7, 17, and 27: Curbow discloses a system and method of using presence information to delay dialing phone calls initiated by a caller to a callee as in Claims 5, 15, and 25 above, further comprising showing the current status of a call in progress to the user who initiated the call (page 4, paragraph 56). This system does not explicitly disclose the communication mode activity information indicates whether said remote computer user initiated the communication session. However, Official Notice is taken that it is old and well known in the art to determine which user initiated the call. For example, telephone companies routinely determine the initiation of a long distance call in order to charge the appropriate fees. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to disclose the identity of the user that initiated the call. One would have been motivated to disclose the identity of the user that initiated the call to ensure more accurate record keeping.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8-10, 18-20, and 28-30 rejected under 35 U.S.C. 103(a) as being unpatentable over Curbow et al. (US 7,076,043) in view of Godefroid et al. (US 6,697,840).

Claims 8, 18, and 28: Curbow discloses a system and method of using presence information to delay dialing phone calls initiated by a caller to a callee as in Claims 1, 11, and 21 above, but does not explicitly disclose presenting an interface to said user of said local computer system, that indicates whether communication mode activity information regarding said user of local system is to be shared with others. Godefroid discloses a similar system for presence awareness in collaborative systems, that further discloses that queries regarding the private data of a user, for example, recent collaborative activities can be allowed or disallowed (column 6, lines 12-18). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to specify whether the communication mode activity information in Curbow is allowed to be accessed by remote users. One would have been motivated to



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specify which communication mode activity information is available for privacy purposes.

Claims 9, 19, and 29: Curbow and Godefroid disclose a system and method of using presence information to delay dialing phone calls initiated by a caller to a callee as in Claims 1, 11, and 21 above, and Godefroid further discloses presenting an interface to a local user that enables the user to specify which communication mode activity information regarding said user is to be shared with other users (column 6, lines 12-18). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to specify which communication mode activity information is to be shared with others. One would have been motivated to specify which communication mode activity information is available for privacy purposes.

Claims 10, 20, and 30: Curbow and Godefroid disclose a system and method of using presence information to delay dialing phone calls initiated by a caller to a callee as in Claims 1, 11, and 21 above, and Godefroid further discloses queries regarding the private data of a user can be explicitly allowed or disallowed (column 6, lines 12-18). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to present an interface to a user that enables the user to specify one or more users with which the communication mode activity information is to be shared. One would have been motivated to specify which communication mode activity information is available to certain colleagues for privacy purposes.

***Response to Arguments***

8. Applicants' arguments filed on April 23, 2007 have been fully considered but they are not persuasive.

Claim 32: Applicants argue the rejection of Claim 32 as being directed to non-statutory subject matter. In response to Applicant's argument, it is respectfully submitted that Claim 32 is not limited to tangible embodiments. In view of Applicant's disclosure, specification page 42, line 6, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., floppy disks and hard drives) and intangible embodiments (e.g. carrier wave signaling techniques). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Claims 1, 11, 21, 31, and 32: Applicants argue that "nothing in Curbow et al. provides a hint of even the desirability of presenting an identity of at least one asynchronous communication application used by the remote computer system user in a display for the local computer system."

In response to Applicant's argument, it is respectfully submitted that Curbow discloses the current invention as claimed above. Curbow discloses a buddy list that indicates the last asynchronous communication application (phone, email, etc.) that was used by a remote user (page 4, paragraph 55/Figure 3). The remote user may be using the buddy list application, and asynchronously using a PDA or office phone for example.

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Claims 8-10, 18-20, and 28-30: Applicants argue that “nothing in the combination of Curbow et al. and Godefroid et al. provides a hint of even the desirability of presenting an identity of at least one asynchronous communication application used by the remote computer system user in a display for the local computer system.”

In response to Applicant’s argument, it is respectfully submitted that Curbow discloses the current invention as claimed above. Curbow discloses a buddy list that indicates the last asynchronous communication application (phone, email, etc.) that was used by a remote user (page 4, paragraph 55/Figure 3). The remote user may be using the buddy list application, and asynchronously using a PDA or office phone for example. Examiner notes that Curbow exclusively discloses the limitations of independent Claims 1, 11, and 21, as discussed above, and the argument that the combination of the two references does not show the claimed invention is moot in view of the Godefroid reference being relied upon strictly for dependent Claims 8-10, 18-20, and 28-30.

9. Examiner Note: The amendments to the specifications and Fig. 23 overcome the objections. The objections have been withdrawn.

### ***Conclusion***

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omar Abdul-Ali whose telephone number is 571-270-1694. The examiner can normally be reached on Mon-Fri(Alternate Fridays Off) 8:30 - 6:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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7/01/2007

  
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